

**UNITED STATES DISTRICT COURT**  
**DISTRICT OF MINNESOTA**

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LOUIS KEMP, SUPERIOR SEAFOODS,  
INC., and QUALITY FINER FOODS,  
INC.,

Civil No. 5-96-173 (JRT/RLE)

Plaintiffs,

**FINDINGS OF FACT,  
CONCLUSIONS OF LAW AND  
ORDER FOR JUDGMENT**

v.

BUMBLE BEE SEAFOODS, INC.,

Defendant.

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John D. Kelly, HANFT FRIDE O'BRIEN HARRIES SWELBAR &  
BURNS, 1000 US Bank Place, 130 W Superior Street, Duluth, MN, 55802-  
2094, for plaintiffs.

John P. Passarelli, Patrick C. Stephenson, Brian T. McKernan, MCGRATH  
NORTH MULLIN & KRATZ, 1400 One Central Park Plaza, 222 South  
Fifteenth Street, Omaha, NE, 68102, for defendant.

This matter came on for trial before the Court on May 20, 21 and 22, 2002 to determine whether Louis Kemp's use of his personal name on a line of wild rice food products infringes or dilutes defendant's Louis Kemp and Louis Kemp Seafood Co., trademarks for surimi-based seafood products. Based on the entire record and proceedings and the arguments of counsel, the Court makes the following findings of fact and conclusions of law.

FILED \_\_\_\_\_  
RICHARD D. SLETTEN, CLERK  
JUDGMENT ENTD. \_\_\_\_\_  
DEPUTY CLERK \_\_\_\_\_

## **FINDINGS OF FACT**

1. The Kemp family has been engaged in the wholesale and retail sale of seafood since 1930. In 1985, Louis Kemp (“Kemp”) started Kemp Foods, Inc., a company that made and sold artificial crab products made from surimi, a low-fat processed fish product.

2. On March 30, 1987, Kemp sold his surimi-seafood business to Oscar Mayer Foods Corporation (“Oscar Mayer”) pursuant to a Stock Acquisition Agreement (“the Agreement”).

3. As part of the Agreement, Kemp transferred all of the trademarks used in connection with that business, including KEMP, KEMP’S and KEMP’S & Design, to Oscar Mayer. The Agreement also placed contractual restrictions on Kemp’s right to use the marks in the future. These restrictions, embodied in sections 7.5., 7.6 and 7.7 of the Agreement, provide:

7.5 Seller represents and warrants that Seller or any entity in which Seller has an interest (except for Company) has never engaged and is not presently engaged in marketing, selling, or otherwise distributing at retail any product bearing the name KEMP, KEMP’S, KEMP’S & Design or any variation thereof except as disclosed and described in Exhibit 35 attached hereto. Seller agrees that neither Seller, nor any entity in which Seller has an interest, shall in the future market, sell or otherwise distribute any product except as provided in Section 7.6 and 7.7 or any other food or any other food or beverage product either at wholesale or retail bearing the name KEMP, KEMP’S, KEMP’S & Design or any variation thereof.

7.6 Seller agrees that within nine months, Seller or any entity in which Seller has an interest, shall cease all use of the name KEMP, KEMP’S, and KEMP’S & Design in connection with the marketing, selling or otherwise distributing of any products.

7.7 It is agreed that Seller or any entity in which Seller has an interest, may market, sell or otherwise distribute those products identified on Exhibit 36, attached hereto, bearing a composite trademark consisting of

the word KEMP or KEMP's and preceded by one or more additional words the selection of which shall be approved in advance in writing by Buyer. The terms of said Exhibit 36 may not be changed or modified except with the approval by Buyer, such approval not to be unreasonably withheld, and by an instrument in writing duly signed on behalf of Buyer and Seller. It is the intention of the parties to avoid any likelihood of confusion among consumer resulting from the use of the respective marks of Seller and Buyer. It is further agreed that the companies described in Exhibit 37 as indicated in Exhibit 37 attached hereto for all purposes except in connection with the marketing, selling or distribution of products.

4. Approximately six months after the parties finalized the Agreement, Lee Scheele, Oscar Mayer Vice-President, asked Kemp if Oscar Mayer could use Kemp's personal name, Louis Kemp, to market its surimi-based seafood products. This was the first time anyone had contemplated using Louis Kemp in connection with the sale of Kemp products. Oscar Mayer desired to use Kemp's full name because the company had achieved significant success in the past by using the first and last names of individuals as trademarks, such as Oscar Mayer and Louis Rich for certain of its processed food products. Kemp granted Scheele's request to use his name on surimi seafood products as a favor and for no additional consideration. Oscar Mayer then expended considerable capital marketing the Louis Kemp mark.

5. Thereafter, the parties entered negotiations to amend the 1987 agreement and put the oral agreement in writing. According to David Fairbairn, an attorney from Kinney & Lange who represented Kemp during the negotiations of the amendment, Kraft initially requested the right to use Louis Kemp on all products. This request was rejected by Kemp, who stated that he had only given Oscar Mayer the limited right to use the mark on surimi products.

6. Counsel for Kraft also attempted to get Kemp to agree to a provision which would have contractually precluded Kemp from using Louis Kemp to sell food products.<sup>1</sup> Kemp refused to agree to this unlimited blanket preclusion.

7. Another draft version of the amendment contained a clause which expressly reserved Kemp's right to use Louis Kemp on other products. This language, however, did not end up in the final version.

8. On June 23, 1989, the parties entered into Amendment 1 to the 1987 Agreement (the "Amendment"). Section 7.8 of that Amendment provides, in its entirety:

Seller grants to Buyer (a) the right to use and register the mark LOUIS KEMP, any design marks incorporating LOUIS KEMP and/or LOUIS KEMP SEAFOOD COMPANY in the United States and elsewhere for surimi-based seafood products and such other seafood and fish accessory products within the natural zone of product expansion; and (b) the right to adopt, use and register the name LOUIS KEMP SEAFOOD COMPANY in the United States and elsewhere as a trade name or as the corporate, firm or business title of any business, operating division or subsidiary of Buyer for the sale of surimi-based seafood products and such other seafood and fish accessory products within the natural zone of product expansion. Seller hereby agrees to reasonably cooperate with Buyer in obtaining trademark registrations, corporate, firm or business title recordals and/or trade name recordals that involve or include the name described in this section 7.8 and shall execute, at no expense to Seller, all consents and documents reasonably necessary for said registrations and recordals. Seller further

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<sup>1</sup> In September 16, 1998 draft of the amendment, Kraft proposed section 7.9, which read, in relevant part, as follows:

Seller acknowledges and agrees that he does not have, either now or at any time in the future, (i) the right to use, or to authorize anyone else to use, the names "Kemp," Kemp's" **and/or "Louis Kemp" alone or in conjunction with any other names or words**, as the corporate, firm or business title, trade name or trademark of any business in any part of the United States or elsewhere in the world engaged in the production, sale or distribution of food and beverage products, except as provided in paragraphs 7.6 and 7.7 herein.  
...

Pl's Exh. 13 (Draft 9/16/88) (emphasis added).

agrees that it shall not attack or assist another in attacking the validity of the trademark LOUIS KEMP or any design marks incorporating LOUIS KEMP or any registration thereof permitting hereunder or the trade name LOUIS KEMP SEAFOOD COMPANY or any records thereof owned by Buyer in the United States or elsewhere.

9. The Amendment also deleted and inserted a revised version of section 7.7, which provides, in relevant part:

It is agreed that Seller, or any entity in which Seller has an interest, may utilize a composite trademark consisting of the word KEMP or KEMP'S and preceded or followed by one or more additional words the selection of which shall be approved in advance in writing by Buyer in connection with the marketing, selling or distribution of those products identified in Exhibit 36.

The Amendment expressly provides that "except as hereinabove amended, all other provisions of the Agreement shall remain in full force and effect."

10. On August 25, 1992, Oscar Mayer, through its parent corporation Kraft General Foods, sold its surimi-seafood business to Tyson Foods, Inc. ("Tyson"). Tyson has since sold its rights to the LOUIS KEMP mark to Bumble Bee Seafoods, which was in turn acquired by Con Agra Foods ("Con Agra").

11. Prior to October 1995, defendant and its predecessors had actively promoted and advertised the LOUIS KEMP mark. From 1987 to 1991, the Louis Kemp Seafood Company spent over \$49 million in advertising and promoting its products under the LOUIS KEMP marks. Def's Exh. at 33, p. 33.

12. By October 1995, the LOUIS KEMP mark had achieved a brand awareness of 47%. At the same time, the Louis Kemp Seafood Company held a 77% share of the market for retail pre-packaged seafood and LOUIS KEMP was the number one surimi seafood brand with a 55% market share. Def's Exh. 31-33.

13. In 1995, plaintiff started considering the use of his personal name in connection with wild rice products. In correspondence written in April 1995, Kemp wrote that “[n]on-fish products can use the ‘Louis Kemp’ brand name which has national recognition with over \$50 million spent on advertising, 20 million lbs of ‘Louis Kemp’ product sold annually with a 67% market share of the prepackaged retail market in its category.” Def’s Exh. 70. In a May 2, 1995 letter, Kemp wrote: “We could use the ‘Louis Kemp’ brand name where we can and want to, to take advantage of the considerable equity it possesses and or any and all other brands the company can utilize.” Def’s Exh. 38.

14. Kemp sought and obtained a legal opinion concerning his right to use the mark for precooked wild rice products. In a letter dated June 27, 1995, David Fairbairn rendered the following opinion:

In my opinion, you have the right to use your name for products which are unrelated to surimi-based seafood products and the related accessory products defined in Amendment No. 1. Precooked wild rice products of the type that you have described to me do not fall within any consent which you have ever given and are sufficiently different from fish products that there should be no problem with the likelihood of confusion created by your use.

On that point, I do want to add some words of caution.

First, you should avoid the use of “Louis Kemp Seafood Company.”

Second, you should avoid using a type font or script which would make your use of “Louis Kemp” similar in appearance to the way in which Tyson is using “Louis Kemp.”

Third, none of the products involved should contain “surimi.”

Pl’s Exh. 26 (June 27, 1995 letter).

15. In October 1995, plaintiff Quality Finer Foods (“Quality”), a company of which Kemp is the president, started using LOUIS KEMP in connection with the sale of seasoned wild rice, chicken wild rice soup and wild rice with stir fry vegetables.

16. On March 13, 1996, representatives of Tyson sent Kemp a cease and desist letter on the basis that consumers are likely to confuse his Louis Kemp wild rice products with Tyson’s seafood products. On March 21, 1996, Kemp responded to the letter, explaining that the subject agreements permitted him to continue using Louis Kemp on non-surimi-based products. Shortly thereafter, Kemp initiated this lawsuit.

17. The Patent and Trademark Office refused Kemp’s trademark application for Louis Kemp on precooked wild rice products on the ground that Kemp’s mark is confusingly similar to defendant’s marks.

18. Plaintiffs stopped marketing their line of wild rice products in late 1998.

## **CONCLUSIONS OF LAW**

### **I. Jurisdiction**

The Court has subject-matter jurisdiction over this matter pursuant to 15 U.S.C. § 1121; 28 U.S.C. §§ 1332, 1338(a) and (b) and supplemental jurisdiction under 28 U.S.C. § 1367(a). Venue is proper pursuant to 28 U.S.C. § 1391(b) and (c).

### **II. Issues Before the Court**

As an initial matter, the Court must first determine what issues are properly before it for resolution. At summary judgment, the central issue before the Court was whether Kemp had contractually precluded or reserved his right to use his personal name under the 1987 Agreement as amended by Amendment No. 1 in 1989. By order dated

March 31, 2001, the Court concluded that the contractual language in question was ambiguous, therefore requiring the issue be submitted to the trier of fact. The Court thus summarized the issues remaining for trial as follows: 1) whether plaintiffs are contractually precluded from using the name and trademark LOUIS KEMP on non-surimi food products such as wild rice; and 2) whether plaintiffs are precluded from using the name and trademark under principles of trademark law. However, on May 22, 2001, the parties entered into a Stipulation and Order Granting Consent Judgment and submitted it for the Court's signature. Paragraph 11 of the Agreement states:

Accordingly, the only issues remaining in the present litigation are whether the use by Kemp of the trademark LOUIS KEMP or any formative of this mark in connection with rice products, including without limitation "seasoned wild rice, chicken wild rice soup, and wild rice with stir fried vegetables" as well as "southwestern white and wild rice, cooked and seasoned white and wild rice and wild and white rice stir fry" (all as identified by Kemp in response to Tyson's interrogatory No. 1) infringes and/or dilute Tyson's rights in the LOUIS KEMP marks.

At a motion in limine heard just before trial, defendant's counsel argued that, in light of the May 2001 consent judgment, there is no longer any contractual issue before the Court to resolve. Upon review of the Agreement, the Court must agree with defendant on this point. In the Court's view, it was plaintiffs' declaratory judgment claim which provided the basis upon which to determine the parties' contractual rights to the Louis Kemp name. But that claim was dismissed with prejudice in paragraph 9 of the consent judgment. Furthermore, the language of paragraph 11 is very clear.<sup>2</sup> Accordingly, the

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<sup>2</sup> The Court, however, agrees with plaintiffs that the existence and negotiations of the Agreement, as amended, may be a factor in the infringement analysis, particularly as to the issue of Kemp's intent to use his personal name on wild rice products.



only claims remaining before the Court are defendant's claims under federal and state law that Kemp's adoption and use of the LOUIS KEMP mark for a line of wild rice products infringes or dilutes defendant's trademark rights in the same name. The Court addresses each of these claims in turn.

#### **A. Trademark Infringement**

The ultimate issue in a claim of trademark infringement is whether the accused mark so resembles the owner's mark that its use is "likely to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1114(1). "Likelihood of confusion is a finding of fact." *SquirtCo v. Seven-Up Co.*, 628 F.2d 1086, 1091 (8<sup>th</sup> Cir. 1980). In determining whether a likelihood of confusion exists, the Court considers the following factors: (1) the strength of the owner's mark; (2) the similarity of the owner's mark and the alleged infringer's mark; (3) the degree to which the products compete with each other; (4) the alleged infringer's intent to "pass off" its goods as those of the trademark owner; (5) incidents of actual confusion; and (6) the type of product, its costs and conditions of purchase. *Co-Rect Prod. v. Marvy! Adver. Photography*, 780 F.2d 1324 (8<sup>th</sup> Cir. 1985). No single factor is dispositive; numerous factors must be weighed and considered. *SquirtCo.*, 628 F.2d at 1091.<sup>3</sup>

In this case, plaintiffs do not appear to dispute the first and sixth factors. Instead, the factors most in dispute involve the similarity of the marks, the degree of competition, whether Kemp intended to capitalize on the strength of defendant's mark for surimi-

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<sup>3</sup> The standard for defendant's counterclaims under the Minnesota Deceptive Trade Practices Act (Counts VI-VII) and for common law unfair competition and trademark infringement (Counts IX-X) follow the same "likelihood of confusion" standard noted above.

seafood products and evidence of actual confusion. The Court addresses each of these factors.

### **1. Similarity of the Marks**

Defendant argues that this factor weighs in its favor because the marks at issue are identical. Defendant also relies on the fact that in each of the applications that the United States Patent and Trademark Office refused, it observed that the marks were “nearly identical in sound and commercial impression.”

“The use of identical dominant words does not automatically mean that two marks are similar, however.” *Luigino’s Inc. v. Stouffer Corp.*, 170 F.3d 827, 830 (8<sup>th</sup> Cir. 1999) (Lean ‘N Tasty not confusingly similar to Lean Cuisine) (citing *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8<sup>th</sup> Cir. 1987) (Oatmeal Raisin Crisp not confusingly similar to Apple Raisin Crisp)). In examining the similarity of the two marks, a court “must look to the overall impression created by the marks, not merely compare individual features.” *Id.* Accordingly, it is necessary to consider “the marks’ visual, aural, and definitional attributes and compare the trade dress of the products in determining whether the total effect conveyed by the two marks is confusingly similar.” *Id.*; *see also General Mills*, 824 F.2d at 627 (explaining that the court should focus on the total effect conveyed by both marks, including color schemes, lettering styles and box designs).

In this case, although the two marks incorporate the same name, Louis Kemp, the trade dress of the two packages is visually distinct. Indeed, plaintiffs made a conscious effort to differentiate its wild rice products from the surimi products of defendant. In doing so, Kemp sought the advice of counsel. In compliance with this advice, plaintiffs

used Louis Kemp as its brand name and avoided the use of, or reference to, Louis Kemp Seafood Company on its packages. Moreover, plaintiffs used color, art and a type font on its packages that were clearly different from those used on defendant's packages. For instance, on defendant's packages the Louis Kemp Seafood Co. mark is written in varying font lettering and appears against a blue background; on plaintiffs' package Louis Kemp is written in constant block lettering against a red striped background. Furthermore, plaintiff's packages predominantly display the words "wild rice" as opposed to Louis Kemp and the product is depicted amidst an outdoor scene of lakes and wild rice. Finally, defendant's surimi products are packaged in a see-through container whereas plaintiff's products are packaged in a box. Accordingly, after comparing the respective color schemes, lettering styles and box designs, the Court concludes that the two marks are different enough to avoid consumer confusion.<sup>4</sup>

## **2. Degree of Competition**

The Court next determines that the products in question do not compete with each other in the marketplace. As an initial matter, the products are very different from one another. Defendant sells surimi seafood, while plaintiff sells wild rice. Nonetheless, defendant contends that the products are closely related because defendant often markets its seafood products with rice as an accompanying side dish. Defendant emphasizes its

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<sup>4</sup> Although defendant points to caselaw which suggests that findings of the PTO are entitled to deference, they are not controlling. *Goya Foods, Inc. v. Tropicana Prods. Inc.*, 846 F.2d 848, 853 (2d Cir. 1988) ("The record made in the Patent and Trademark Office is admitted in evidence, but the factfinding of that office is not conclusive, nor is the court's consideration limited to that record."). In addition, it does not appear that the PTO took into account the overall impression of the marks, such as the trade dress, which this Court has done in making its determination.

promotional efforts which sometimes include recipes featuring LOUIS KEMP surimi products with rice and the joint promotion it sponsored with SUCCESS rice. Defendant also points to evidence in plaintiffs' promotional advertising in which Quality Finer Foods markets its rice products with seafood.

The Court is unpersuaded by this argument. Defendant's promotional materials suggest recipes with a wide variety of side dishes, including pasta, salad, stir-fry vegetables, crackers, spinach, or as part of a dip or casserole. Def's Exh. 30. Rice is just one of the many suggested tie ins. Likewise, plaintiffs' promotional materials mention seafood in generic fashion as one of over a dozen serving suggestions. Def's Exh. 75 at 6. Accordingly, though both parties' advertising material contain occasional references to rice or seafood, the Court does not find this connection sufficient to conclude they are in competition.

### **3. Intent**

"Intent on the part of the alleged infringer to pass off its goods as the product of another raises an inference of likelihood of confusion, but intent is not an element of a claim for trademark infringement." *Squirtco*, 628 F.2d at 1091. Defendant claims that plaintiff selected the LOUIS KEMP mark for his wild rice line specifically to take advantage of the millions of dollars of advertising and promotion that had been expended by Tyson and its predecessor Oscar Mayer. To support this argument, defendant points to several statements Kemp made in various letters in which he refers to the "considerable equity [defendant] possesses" and its considerable market share.

While the above statements may at first glance appear to favor defendant, these statements cannot be considered in isolation. Rather, this case presents an extensive history of contract negotiations and agreements concerning the scope and right to use plaintiff's personal name. Pursuant to these extensive negotiations and written agreements, Kemp believed he retained the right to continue using Louis Kemp on all products other than surimi products. The statements Kemp made above were all made in connection with this contractual understanding.<sup>5</sup> It is also significant that Kemp sought and obtained a legal opinion from Mr. Fairbairn concerning his right to use the LOUIS KEMP mark before launching his products on the market. Plaintiff's actions in attempting to differentiate his product from defendant's products negate any intent on his part to deliberately trade off defendant's goodwill and create consumer confusion.

#### **4. Evidence of Actual Confusion**

"When determining whether there exists a likelihood of confusion, weight is given to the number and extent of instances of actual confusion." *Life Technologies, Inc. v. Gibbco Scientific, Inc.*, 826 F.2d 775, 777 (8<sup>th</sup> Cir. 1987). In this case, defendant points to no incidents of actual consumer confusion.<sup>6</sup> Although plaintiffs' wild rice products were on the market for three years, defendant has not presented any evidence, either

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<sup>5</sup> Even though a court may adopt a different interpretation of what rights were preserved or precluded under the 1987 Agreement and 1989 Amendment, this does not preclude the Court from finding, on the specific question of plaintiff's intent, that plaintiff had an understanding of the Agreements, which influenced his actions in the spring of 1995.

<sup>6</sup> Defendant's reliance on the testimony of Patrick Melby, a former employee of Quality Finer Foods, is misplaced. The Court does not extract from his testimony the inference or conclusion that confusion among brokers was rampant.

through consumer inquiries or complaints, which suggest that the placement and sale in grocery stores with the surimi products caused consumer confusion. *Luigino's*, 170 F.3d at 829-30 (company had no reports of actual confusion between the two products). In addition, plaintiff testified to the fact that his company sold fish products under the Kemp's name for many years in the same grocery stores where dairy products were sold under the Kemp's name by Marigold Foods. Yet, no complaints of consumer confusion resulted from that lengthy experience of these different products being sold under the Kemp's mark in the same stores. William McClennan, vice-president of sales and marketing at Conagra, also testified that he was not aware of any reports of actual confusion between its products for surimi seafood and Kemp dairy products.

Defendant suggests that a consumer survey conducted by Henry Ostberg establishes proof of consumer confusion. According to Ostberg, the survey he conducted demonstrated that approximately 25% of the consumers who are confronted with plaintiffs' and defendant's products in the marketplace will be confused as to the source, sponsorship or approval of the products. There are several indicia of reliability a court can consider in assessing the validity of a consumer survey. These factors include whether: "the population was properly chosen and defined; the sample chosen was representative of that population; the data gathered were accurately reported; the data were analyzed in accordance with accepted statistical principles; the questions asked were clear and not leading; the survey was conducted by qualified persons following proper interview procedures; and the process was conducted to ensure objectivity." *Sports Authority, Inc. v. Abercrombie & Fitch, Inc.*, 965 F. Supp. 925, 933 (E.D. Mich. 1997) (quoting the *Manual for Complex Litigation, Third*, § 21.493 (1995)).

The Court has reviewed the survey in question and finds it deficient in several respects. First, the Court cannot determine whether the sample, consisting of only females, was representative of the grocery shopping public. The Court also finds that the interviewees may have been confused by the wording of some of the questions posed to them. For instance, the first question asked of interviewees after reviewing the two portfolios was: “Do you think that there was a product with the same brand name or put out by the same company as this packaged wild rice in the first group of food products you saw before?” The interviewees may well have been confused by the compound nature of the question put to them. The Court is also troubled by the small sample of products contained in each portfolio. The Court therefore gives less weight to defendant’s survey. *Squirtco*, 628 F. 2d at 1091 (“In evaluating survey evidence, technical deficiencies go to the weight to be accorded them, rather than to their admissibility.”). Given the lack of evidence of actual consumer confusion and the deficiencies in the survey, the Court concludes that this factor does not weigh in defendant’s favor.

In sum, with respect to the factors the Court must consider in determining the likelihood of confusion, the factors of the strength of the owner’s mark and the degree of care exercised by customers weigh in defendant’s favor. However, the Court’s findings that the marks are not confusingly similar, the absence of any competition between the products, the weakness of the alleged evidence of an intent to infringe and the minimal weight the Court accords defendant’s survey all weigh in favor of plaintiffs. The Court reiterates that likelihood of confusion is a question of fact and that it is defendant’s

burden to prove likelihood of confusion. For the reasons set forth above, the Court, as the trier of fact, concludes that defendant has failed to carried its burden in this regard.

## **B. Trademark Dilution**

Section 43(a) of the Lanham Act provides a remedy for dilution of famous trademarks. Under the statute, the owner of a famous mark is entitled to enjoin another person's commercial use of a mark if it causes dilution of the distinctive quality of the mark. 15 U.S.C. § 1125(c). To succeed on its dilution claim, Bumble Bee must prove: 1) the fame of the senior mark; 2) the junior use of the mark in commerce; 3) the junior use begins after the senior mark has acquired fame; and 4) dilution of the senior mark caused by the junior user's use of the mark. *Luigino's*, 170 F.3d at 832; *American Dairy Queen, Corp. v. New Line Prod. Inc.*, 35 F. Supp. 2d 727, 732-33 (D. Minn. 1998).

In this case, the Court concludes that even if defendant carried its burden on the first three elements, it has not shown that plaintiffs' use of his personal name in connection with wild rice products dilutes the distinctive quality of the LOUIS KEMP marks. In *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 217-22 (2d Cir. 1999), the Second Circuit set out the following eight-factor test in considering whether dilution has occurred: 1) the degree of distinctiveness of the senior user's mark; 2) the similarity of the marks; 3) the proximity of the products and likelihood of bridging the gap; 4) the interrelationship among the distinctiveness of the senior mark, the similarity of the junior mark and the proximity of the products; 5) shared consumers and geographic limitations; 6) sophistication of consumers; 7) actual confusion; 8) adjectival or referential quality of



the junior use; 9) harm to the junior user and delay by the senior user; and 10) effect of senior's prior laxity in protecting the mark.

The Court concludes that defendant has not carried its burden on this claim as well. As the Court has already determined above, the overall impression of the marks are different enough to avoid confusion, there is no specific evidence of actual confusion, the Court grants minimal weight to the survey, and the products are not in proximity to each other. Indeed, as Mr. McLennan acknowledged, the fact that a consumer might pick up a pack of seasoned wild rice does not mean that the same consumer would pass by the package of surimi crab meat.

Thus, for all the foregoing reasons, the Court concludes that defendant has not carried its burden of proof as to either its trademark infringement or dilution claims. The Court therefore rules in plaintiffs' favor.

### **ORDER**

Based on the submissions of the parties, the arguments of counsel, and the entire file and proceedings herein, **IT IS HEREBY ORDERED** that the Court finds in favor of plaintiffs and against defendant on defendant's federal and state trademark infringement and dilution claims. Counts II-XI of defendant's counterclaim [Docket No. 8] are accordingly **DISMISSED WITH PREJUDICE**.

**LET JUDGMENT BE ENTERED ACCORDINGLY.**

DATED: September 30, 2002  
at Minneapolis, Minnesota.

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JOHN R. TUNHEIM  
United States District Judge